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10/577,519	04/26/2006	Franz Amtmann	AT03 0061 US1	9607

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EXAMINER

DUDEK JR, EDWARD J

ART UNIT	PAPER NUMBER
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2186

NOTIFICATION DATE	DELIVERY MODE
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12/08/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ip.department.us@nxp.com

Office Action Summary	Application No. 10/577,519	Applicant(s) AMTMANN, FRANZ	
	Examiner Edward J. Dudek	Art Unit 2186	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 April 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office Action is responsive to the amendment filed on 17 September 2008 in application #10/577,519.

Claims 1-6 and 8-14 are pending and have been presented for examination.

Response to Arguments

Applicant's arguments filed 17 September 2008 with respect to claims 1-10 and 12 have been fully considered but they are not persuasive.

Applicant argues:

Takahashi thus describes a memory that may be accessed and rewritten (erased) a predetermined number of times. Takahashi does not teach or reasonably suggest a memory that can alternate between at least two states. That is, the memory of Takahashi is described as being in a writable state until the predetermined number of erasures is exceeded. In contrast, the limitations of claims 1 and 5 (as amended) are drawn to a method and an integrated circuit that can toggle between an active state (allowing access to data stored in a data carrier) and a quiet state (denying access to the data stored in the data carrier).

Claims 1 and 5 (as amended) thus recite limitations not taught or reasonably suggested by Takahashi and are therefore, not anticipated by Takahashi.

The Examiner respectfully disagrees. Claims 1 and 5 as amended are only directed toward the instance of starting with a memory in the active state and programming a memory cell to put the memory in a quiet state. There are no limitations in claims 1 and 5, or any dependant claims, that require the memory to be able to alternate between the two states as argued. Takahashi discloses an EPROM that contains a number of memory cells that equal the number of times the user memory of

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the card can be rewritten. When the last initialization takes place, the last memory cell in the EPROM is programmed and the memory would then be in a quiet state since access to the user memory would no longer be permitted. This is exactly what is required for claims 1 and 5. The rejection is maintained as repeated below.

Drawings

The drawings are objected to because the figures lack descriptive text labels to describe the steps in the flow charts of figure 1 and the physical elements of figures 2-4. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5-6 and 8-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 recites the limitation "the programming unit" in line 18. There is insufficient antecedent basis for this limitation in the claim.

Claims 6 and 8-14 are also deficient as they depend from claim 5.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-4 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 1 is a method claim, and is therefore claiming a process. The claim does not satisfy the machine or transformation test as laid out by the Supreme Court. With regard to the machine test, there are no limitations in the claim that tie the process to another statutory category such as a machine or article of manufacture. With regard to the transformation test, the process claimed does not perform a physical transformation

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of the underlying subject matter. Since the claim fails the machine or transformation test the claim is non-statutory.

Claims 2-4 are also deficient as they depend from claim 1.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 5-6, 8-10, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Takahashi (**U.S. Patent #5,504,701**).

As per claim 1: Takahashi discloses a method for securing data of a data carrier comprising: determining a current state of a memory (**see column 4, lines 33-49**), wherein the memory comprises a plurality of memory cells (**see column 3, lines 55-65**) and wherein the current state of the memory is selected from the group consisting of and active state and a quiet state and wherein in the active state the data of the data carrier is accessible (**see column 5, lines 35-50**) and wherein in the quiet state the data of the data carrier is inaccessible (**see column 6, lines 28-45**); if the memory is in the active state, then determining a current state of a memory cell (**see column 6, lines 6-16**), wherein the current state of the memory cell is selected from the group consisting of a programmed state and an unprogrammed state (**see column 6, lines 18-24**); and if the current state of the memory cell is the unprogrammed state, then selecting the

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memory cell and programming the selected memory cell to change the current state of the memory cell to the programmed state (**see column 6, lines 6-24**), wherein the memory cell assumes an irreversible memory state as a result of the programming (**see column 3, lines 50-67**) and wherein the memory enters the quiet state (**see column 6, lines 18-24, if this is the last time remaining, then the memory would enter a quiet state since the user memory is no longer accessible**).

As per claim 2: prior to determination of the current state of the memory, verifying authorization to access the memory (**see column 8, lines 40-44**).

As per claim 5: Takahashi discloses an integrated circuit for securing data stored in a data carrier comprising: a memory comprising a plurality of memory cells (**see column 3, lines 55-65**) a first logic circuit configured for determining a current state of the memory (**see column 4, lines 33-49**), wherein the current state of the memory is selected from the group consisting of an active state and a quiet state and wherein in the active state the data of the data carrier is accessible (**see column 5, lines 35-50**) and wherein in the quiet state the data of the data carrier is inaccessible (**see column 6, lines 28-45**); a feed-logic circuit, wherein the feed-logic circuit is configured for: receiving state information indicative of a current state of a memory cell (**see column 6, lines 6-16**), wherein the current state of the memory cell is selected from the group consisting of a programmed state and an unprogrammed state (**see column 6, lines 18-24**); and if the current state of the memory cell is the unprogrammed state; and if the current state of the memory is the active state and if the current state of the memory cell

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is the unprogrammed state, then selecting the memory cell; and issuing programming command to the programming unit to program the selected memory cell to change the current state of the memory cell to the programmed state **(see column 6, lines 6-24)**, wherein the memory cell assumes an irreversible memory state as a result of the programming **(see column 3, lines 50-67)** and wherein the memory enters the quiet state **(see column 6, lines 18-24, if this is the last time remaining, then the memory would enter a quiet state since the user memory is no longer accessible)**.

As per claim 6: a counter **(see column 6, lines 57-67)**; and a sequencing circuit **(see column 6, lines 57-67)**, wherein the sequencing circuit is configured for: providing a clock signal to a clock input of the integrated circuit via the counter **(see column 6, lines 57-67)**; receiving a serial output from the integrated circuit indicative of the state of each of the plurality of memory cells **(see column 7, lines 1-25)**; and issuing a stop count signal to the counter when a first memory cell in the unprogrammed state is detected, and wherein the counter is configured to count the clock signals to produce a count indicative of the location of the first memory cell in the unprogrammed state **(see column 6, lines 6-24)**.

As per claim 8: prior to determination of the current state of the memory, verifying authorization to access the memory **(see column 8, lines 40-44)**.

As per claim 9: wherein the data stored in the data carrier is selected from the group consisting of preset data and data entered via an input device **(see column 3, lines 27-45)**.

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As per claim 10: a data carrier comprising an integrated circuit according to claim 5 (**see column 2, lines 45-55**).

As per claim 12: wherein the data carrier is in the form of a tag or a label (**see column 2, lines 45-55**).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi (**U.S. Patent #5,504,701**) in view of well known practices in the art.

As per claim 11: Takahashi discloses all of the limitations of claim 10 as discussed above. Takahashi fails to disclose the data carrier is designed for contactless communication with a communication station. Traditionally phone cards have used a magnetic strip to store information concerning the number of minutes available on the card (**see column 1, lines 10-30**), however there can be a counterfeit problem. The card disclosed by Takahashi uses memories to store the information and a count of the number of times the card can be initialized, beyond this count the card becomes useless. The card must somehow communicate with the phone so the information can be updated. There are a number of well known methods, a contact strip or a contactless communication method. With a contact strip, there then must be an exposed contact

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area on the phone that must be protected along with a contact on the card that must be protected. If either were to become damaged, communication may not work. RFID cards are well known, and do not require any exposed contacts to communicate; the card just has to be in the range of the receiver/transmitter built into the communication device. This reduces the risk of damaging contacts on the card and device, and since there are only timing signals being sent back and forth there is not a big demand for bandwidth, therefore a contactless communication method is more than able to handle the data that will be sent between the card and the device, and Official Notice is hereby taken. It would have been obvious to a person having ordinary skill in the art to which said subject matter pertains to have modified the system disclosed by Takahashi to use a contactless card to reduce the possibility of contacts on the card or the telephone from becoming damaged resulting in a failure of the card and the telephone from being able to communicate.

Allowable Subject Matter

Claims 13-14 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward J. Dudek whose telephone number is 571-270-1030. The examiner can normally be reached on Mon thru Thur 7:30-5:00pm Sec. Fri 7:30-4 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Kim can be reached on 571-272-4182. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/E. J. D./
Examiner, Art Unit 2186
December 3, 2008